

ESTTA Tracking number: **ESTTA521912**

Filing date: **02/15/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	J.T. Colby & Company, Inc.
Granted to Date of previous extension	02/16/2013
Address	5 Dering Woods Road Shelter Island Hts., NY 11965 UNITED STATES
Attorney information	Claudia Bogdanos Quinn Emanuel Urquhart & Sullivan , LLP 51 Madison Ave.,22nd Floor New York, NY 10010 UNITED STATES claudiabogdanos@quinnemanuel.com, ulanaholubec@quinnemanuel.com Phone:212-849-7000

Applicant Information

Application No	85008412	Publication date	12/18/2012
Opposition Filing Date	02/15/2013	Opposition Period Ends	02/16/2013
International Registration No.	NONE	International Registration Date	NONE
Applicant	Apple Inc. 1 Infinite Loop Cupertino, CA 95014 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2000/10/27 First Use In Commerce: 2000/10/27
All goods and services in the class are opposed, namely: Software for reading electronic publications on digital electronic devices; computer software for authoring, downloading, receiving, editing, displaying, storing and organizing text, graphics, images, and electronic publications

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	IBOOKS
Goods/Services	Print and electronic books and related goods and services.

Attachments	5175556_1_TTAB - Notice of Opp (with Cert of Service).PDF (5 pages) (291015 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ulanaholubec/
Name	Ulana Holubec
Date	02/15/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/008,412
Published in the Official Gazette on December 18, 2012
Mark: IBOOKS

J.T. COLBY & COMPANY, INC.,

Opposer,

Opposition No. _____

-against-

APPLE, INC.,

Applicant.

NOTICE OF OPPOSITION

TO THE COMMISSIONER FOR TRADEMARKS:

Opposer J.T. Colby & Company, Inc. believes it will be damaged by the registration of the mark IBOOKS in the above-identified application and hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1063(a).

As grounds for the opposition, Opposer alleges that:

1. Opposer J.T. Colby & Company, Inc. (“Colby”) is a corporation duly organized and existing under the laws of the State of New York, with its principal place of business at 5 Dering Woods Road, Shelter Island Heights, New York 11965.

2. For many years, and before October 27, 2000, the date of first use alleged in the above-identified application (“Application”)¹, and April 7, 2010, the filing date of the Application, Opposer, directly through its subsidiaries and its predecessors in interest, has used the trademark IBOOKS (“Opposer’s IBOOKS Mark”) on and in connection with print and electronic books, as a publishing imprint.

3. Opposer seeks to identify and stop perceived infringers of Opposer’s IBOOKS Mark.

4. During its long and continuous use of Opposer’s IBOOKS Mark, Opposer, directly through its subsidiaries and its predecessors in interest, has expended considerable time, effort, and money in connection with the publication, distribution, and sale of books under Opposer’s IBOOKS Mark.

5. Opposer, directly through its subsidiaries and its predecessors in interest, has sold, and offered for sale, goods bearing Opposer’s IBOOKS Mark in a trading area of broad geographical scope encompassing, *inter alia*, all of the states and territories of the United States.

6. Opposer, directly through its subsidiaries and its predecessors in interest, has sold, and offered for sale, goods bearing Opposer’s IBOOKS Mark in various channels of trade.

7. Opposer’s IBOOKS Mark has a high degree of distinctiveness due to the duration and extent of its use by Opposer, directly through its subsidiaries and its predecessors in interest, and the volume of sales of books under the IBOOKS imprint.

¹ On information and belief, Applicant’s alleged first-use date is itself inaccurate and misleading, because it depends on an invalid assignment from the original registrant of the IBOOKS mark, which was used in connection with different goods.

8. By the application herein opposed, Applicant seeks to register the designation IBOOKS in International Class 09 for “[s]oftware for reading electronic publications on digital electronic devices; computer software for authoring, downloading, receiving, editing, displaying, storing and organizing text, graphics, images, and electronic publications.”

9. These goods for which Applicant seeks registration are similar to the goods in connection with which Opposer’s IBOOKS Mark is in use.

10. Applicant filed this application on April 7, 2010, many years after Opposer and its predecessors in interest started using Opposer’s IBOOKS Mark.

11. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

12. Registration should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) on the grounds that the designation IBOOKS so resembles Opposer's IBOOKS Mark used consistently by Opposer and its predecessors in interest in the United States, as to be likely, when used on or in connection with the goods identified in the Application, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Oppose and to the public.

13. Registration should be refused pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a) on the grounds that Applicant's use of the designation IBOOKS will falsely suggest a connection between Applicant and Opposer named herein, to the damage of Opposer.

WHEREFORE, Opposer believes it will be damaged by the registration of Applicant's IBOOKS designation for the goods identified in Application Serial Number 85/008,412 and respectfully requests that the opposition be sustained and registration of said designation be denied.

Pursuant to 37 C.F.R. § 2.6(a)(17), Opposer respectfully requests that the three hundred dollar (\$300.00) statutory filing fee, and any additional necessary amount, be charged to Deposit Account Number 50-5708.

Dated: February 14, 2013

Respectfully submitted,

By: Claudia T. Bogdanos

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Attorneys for Opposer J.T. Colby & Company, Inc.

CERTIFICATE OF SERVICE

I certify that on the 15th day of February, 2013, I caused a true copy of the attached Notice of Opposition, in connection with Application Serial No. 85/008,412, to be served on Applicant Apple, Inc., by depositing same with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to the attorney of record for the Applicant as follows:

LISA G. WIDUP
APPLE INC.
1 INFINITE LOOP # MS3TM
CUPERTINO, CALIFORNIA 95014-2083
UNITED STATES

A handwritten signature in blue ink, consisting of a series of loops and a long horizontal stroke extending to the right.

Ulana Holubec, Esq.